

Appin No. 10/743,671  
Amdt. Dated January 12, 2006  
Response to Office Action of December 6, 2005

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### **REMARKS/ARGUMENTS**

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

#### ***Claim Rejections – 35 USC § 103***

At page 3 of the Office Action, the Examiner rejects claims 1 to 14 as being unpatentable over "Intelligent Paper" by M. Dymetman and Max Copperman (herein referred to as 'Intelligent Paper') in view of Soscia (US Patent No 5,996,893).

Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

The applicant submits that due to the following three points, claims 1 to 14 are patentable over "Intelligent Paper" in view of "Soscia. In particular:

#### **POINT 1: INTELLIGENT PAPER DOES NOT IMPLY USING A SINGLE PRINTER**

The Examiner has stated that on page 2 of the Office Action that Intelligent Paper:

*"implicitly suggest that the publisher can print both the visible and invisible codes with the invisible code as invisible ink both under or over the visible ink"*

In particular, the Examiner has highlighted p. 399 1<sup>st</sup> full paragraph. However, the first full paragraph only states that the code layer is printed under the visible ink or that the code layer is printed over the visible ink. Nothing more is taught or suggested by the 1<sup>st</sup> full paragraph at p. 399.

The fact that an **explicit** statement at the 1<sup>st</sup> full paragraph of page 394 describes that an authorised producer prints the encoded pages and that a publisher receives the pre-encoded pages and prints the information on the pre-encoded pages has to surely outweigh any implied suggestion proposed by the Examiner.

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Furthermore, the fact that the implicit disclosure interpreted by the Examiner totally contradicts the explicit disclosure on page 394 must also suggest to the Examiner that the implicit disclosure proposed by the Examiner is respectfully incorrect.

Also, the fact that layering of invisible ink and visible ink is described in the 1<sup>st</sup> full paragraph at page 399, it is fair to suggest the skilled person in the art would also conclude a contrary implicit suggestion to that proposed by the Examiner, wherein the first layer is printed by the authorised producer and that the second layer is printed by the publisher.

Therefore, when a skilled person in the art considers the contrary implicit disclosure suggested by the Applicant in combination with the explicit disclosure at the 1<sup>st</sup> paragraph of page 394, the combination must surely outweigh the Examiner's sole implicit suggestion which totally contradicts the explicit disclosure at the 1<sup>st</sup> paragraph of page 394.

It is fair to suggest that a person skilled in the art with no ingenuity would have to weigh up the disclosure of Intelligent Paper as a whole (as required by MPEP §2143.02 VI) and conclude that if there are two opposing interpretations of a particular paragraph, and an explicit statement elsewhere in the disclosure supports one of those interpretations, the skilled person would follow the interpretation which is consistent with the explicit disclosure, and dismiss the alternative implied and contradictory interpretation.

The Applicant respectfully submits that despite the Examiner's contention that Intelligent Paper implies a printer which prints both the coded data and visible information, there is more than enough evidence in the disclosure of Intelligent Paper to suggest otherwise.

**POINT 2: MPEP §2143.01 V**

This section of the MPEP states:

*"If the claimed modification would render the prior art invention being modified unsatisfactory to its intended purpose, then there is no suggestion or motivation to make the proposed modification"*

The Examiner has argued on page 5 of the Office Action that:

*"It would be obvious to one skilled in the art at the time the invention was made to add Soscia the printers with capabilities of printing both inks and both codes to*

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*INTELLIGENT PAPER so as to allow publishers to print the invisible codes together with the visible information suggested by INTELLIGENT PAPER at see p. 399 1<sup>st</sup> full paragraph."*

However, Intelligent Paper describes at p. 394 1<sup>st</sup> paragraph that an authorised producer produces invisibly encoded sheets of paper, and these encoded sheet are then supplied to a publisher who then uses the encoded sheets to print information using conventional visible inks.

The Examiner cannot simply ignore this disclosure at p. 394 1<sup>st</sup> paragraph.

Intelligent Paper does not provide explicitly disclose any alternative arrangement throughout the description. Thus, a person skilled in the art would only consider operating the Intelligent Paper process as described by having an authorised producer supply encoded sheets and a publisher print visible information on the encoded sheets.

Therefore, in regard to the Examiner's motivation stated above, this modification would cause the publisher to perform both steps of printing the coded data and the printing the information, but more importantly alter and eliminate the intended purpose of the authorised producer, which was to print the encoded sheets.

However, as stated by MPEP §2143.01, modifying the method of Intelligent Paper renders the intender purpose of the authorised producer unsatisfactory. Therefore, there is no suggestion or motivation to make the proposed modification, as per MPEP §2143.01.

**POINT 3: MPEP §2143.02 VI and MPEP §2143.01 II**

MPEP §2143.02 VI states:

*"A prior art reference must be considered as a whole, including portions that would lead away from the claimed invention"*

As stated above, p. 394 1<sup>st</sup> paragraph Intelligent Paper describes that an authorised producer produces encoded paper, implying a first printer is used to print the encoded data on the paper, and the encoded paper is supplied to a publisher which prints the information on the pre-encoded paper, implying a second printer is used to print the information.

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This portion of Intelligent Paper leads away from the claimed method of *"the human-readable information and machine-readable coded data having been printed by the said printer"*. Therefore, when Intelligent Paper is considered as a whole, it would not be obvious to combine the printer of Soscia with Intelligent Paper because portions of Intelligent paper would lead away from the claimed method.

Similarly, MPEP §2143.01 II states:

*"Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. In re Young, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991)"*

Intelligent Paper conflicts with Soscia because Intelligent Paper teaches explicitly that an authorised producer is used to print the coded data on the paper and a publisher prints the information on the pre-encoded paper, which is in total contrast to Soscia which suggests that a single printer could be used to print both the coded data and the information. conflict between the references provides substantial weight to discredit the combination of references.

### SUMMARY

The Applicant submits that:

- as the implied suggestion proposed by the Examiner is inconsistent with other possible implied suggestions which are explicitly supported by the disclosure in Intelligent Paper; and
- as the method described by Intelligent Paper is being modified to render the intended purpose of the authorised producer unsatisfactory; and
- as the Intelligent Paper includes explicit portions which lead away from the disclosure of Soscia;

it is clear that all claims are not obvious in view of Intelligent Paper modified by Soscia.

This conclusion is supported by MPEP §2143.01 II, MPEP §2143.02, and MPEP §2143.01 V which all indicate that the combination of Intelligent Paper in view of Soscia would not be obvious to a person skilled in the art.

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MPEP §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" states that:

*"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."*

As the conclusion in point 2, based on MPEP §2143.01, states that "*there is no suggestion or motivation to make the proposed modification*", the Applicant submits that the first basic requirement of a prima facie case of obviousness has not been met, as the no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

As all three basic requirements must be met in order to render a claim obvious and unpatentable, the Applicant submits that a prima facie case of obviousness has not been shown.

Reconsideration and withdrawal of the rejection is respectfully requested.

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**CONCLUSION**

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

Applicant:



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KIA SILVERBROOK

Applicant:



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